

REMARKS

In the Office Action, the Examiner rejected claims 1-29. By this Response, Applicant amends claims 1, 8, 15, 19 and 26-28 and cancels claim 5. These amendments do not add new matter. Currently, claims 1-4 and 6-29 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and following remarks, Applicant respectfully requests allowance of all pending claims.

Applicant notes that Examiner did not provide any specific rejection of claim 5 in the Office Action. In this Response, Applicant amends claim 1 to recite the subject matter of claim 5. Therefore, Applicant believes claim 1 to be allowable. Further, if the Examiner chooses to provide a rejection of claim 1 in the next office action, Applicant points out that the new ground of rejection was not necessitated by any amendment made in this Response. Accordingly, the next Office Action should not be final. *See* M.P.E.P § 706.07(a).

Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-3, 7, 15-21 and 26-27 as anticipated by JP2002049900 (JP 900). Applicant respectfully traverses this rejection.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicant needs only point to a single element not found in the cited

reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the identical invention "in as complete detail as contained in the ... claim" to support a prima facie case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Further, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969) (emphasis added); M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is "the primary basis for construing the claims." See *Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. See *Id.*

Interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. See *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. "The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation." See *Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on "usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art." See *Id.*

Improper Reliance on an Abstract

In the Office Action, the Examiner relied on an "Abstract of JP2002049900" (JP900 Abstract) to reject the present claims. See *e.g.*, Office Action, pages 2-5 (repeatedly citing the "USE section" of the JP900 Abstract). However, it is improper for the Examiner to rely on the abstract rather than the underlying document itself,

particularly in the case of foreign language references. *See Ex parte Jones*, 62 U.S.P.Q.2d 1206 (PTO Bd. App. 2001); and M.P.E.P. §706.02(II). As noted by the Board of Patent Appeals and Interferences, the reliance on abstracts is problematic, because abstracts are often prone to erroneous or incomplete descriptions of the invention. “A proper examination under 37 C.F.R. § 1.104 should be based on the underlying documents and translations, where needed.” *Id.* Accordingly, for this reason among others, Applicant respectfully requests that the Examiner cite to portions of the underlying document rather than use the JP900 abstract to reject the present claims.

Request for Removal of a Portion of the JP900 Reference

Applicant submits that the three-page Derwent document dated December 4, 2005, is not prior art. The three-page Derwent document, including the Use Section, does not indicate that it is a direct translation from the Derwent document. Thus, there is no indication that the subject matter of the JP900 Abstract was published as of the publication date of Derwent document. Moreover, there is no indication that the Derwent document was published prior to November 26, 2003, the filing date of the present application. Indeed, the Derwent document states “COPYRIGHT 2005 DERWENT INFORMATION LTD” on page 2, and the date at the bottom of each page, presumably indicating the date of printing, is December 4, 2005. Both of these dates are over 2 years after the 2003 filing date of the present application. Thus, the Derwent document is not prior art. Accordingly, Applicant respectfully requests removal of the Derwent document and withdrawal of all rejections relying on the Derwent document.

Request for Translation of the Cited Reference

If the Examiner continues to rely on the JP900 reference, Applicant respectfully requests that the Examiner provide an English translation of this reference. *See* M.P.E.P. §706.02(II).

Features of Claim 1 and its Dependent Claims Absent from the Cited Reference

The JP900 reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest "a radio frequency (RF) transmission device couplable to the component and configured to transmit information regarding the component, wherein the component is configured to provide power to the RF transmission device," as recited by independent claim 1. (Emphasis added.) In contrast, the JP900 reference teaches a passive electromagnetic induction tag 10 coupled to a gear. *See e.g.*, JP900, Fig. 1. The electromagnetic induction tag 10 appears to be powered by a hand-held unit B, and not by the gear A. *See, Id.* Indeed, the gear A disclosed by the JP900 reference does not appear to include any power supply by which it might provide power to the electromagnetic induction tag 10. *See, Id.* Accordingly, the gear A is not configured to provide power to the electromagnetic induction tag 10. Thus, the JP900 reference could not possibly teach *all* of the features of claim 1. In view of these deficiencies among others, the cited reference cannot anticipate claim 1 or the claims that depend therefrom.

Features of Claim 15 and its Dependent Claims Absent from the Cited Reference

With respect to claim 15 and its dependent claims, the JP900 reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest that the "medical device, the medical device component, or a combination thereof is configured to communicate with the RF transmitter," as recited by independent claim 15. (Emphasis added.) In contrast, the JP900 reference teaches a gear A that does not communicate with an attached electromagnetic induction tag 10. *See, Id.* Thus, the JP900 reference could not possibly teach *all* of the features of claim 15. In view of these deficiencies among others, the cited reference cannot anticipate claim 15 or the claims that depend therefrom.

Features of Claim 19 and its Dependent Claims Absent from the Cited Reference

Here again, the JP900 reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest "remotely communicating with the RF

device over a network," as recited by independent claim 19. (Emphasis added.) In contrast, the JP900 reference teaches inductively powering and communicating with an electromagnetic induction tag 10 that is proximate a hand-held unit B. *See id.* Indeed, in each disclosed instance of communication with the electromagnetic induction tag 10, the hand-held unit B is in line-of-sight with the gear A. *See* JP900, Figs. 1 and 13. Thus, the JP900 reference could not possibly teach *all* of the features of claim 19. In view of these deficiencies among others, the cited reference cannot anticipate claim 19 or the claims that depend therefrom.

Features of Claim 26 and its Dependent Claims Absent from the Cited Reference

With respect to claim 26, the JP900 reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest "an active radio frequency (RF) device," as recited by independent claim 26. (Emphasis added.) In sharp contrast, the JP900 reference teaches a passive electromagnetic induction tag 10 that does not draw power from the gear A or other attached power supply. *See, Id.* Thus, the JP900 reference could not possibly teach *all* of the features of claim 26. In view of these deficiencies among others, the cited reference cannot anticipate claim 26 or the claims that depend therefrom.

Features of Claim 27 and its Dependent Claims Absent from the Cited Reference

The JP900 reference is deficient for the following two reasons among others. First, the cited reference does not teach or suggest "means for disabling the RF device from broadcasting during operation of the medical device," as recited by independent claim 27. (Emphasis added.) In sharp contrast, the JP900 reference teaches an electromagnetic induction tag 10 that is not prevented from broadcasting during the operation of the gear A. *See*, Fig. 1. Thus, the JP900 reference could not possibly teach *all* of the features of claim 27. In view of these deficiencies among others, the cited reference cannot anticipate claim 27 or the claims that depend therefrom.

Additionally, the cited reference does not teach or suggest "means for remotely communicating with the RF device," as recited by independent claim 27. (Emphasis added.) To the contrary, as explained above with reference to claim 19, the JP900 reference teaches a hand-held unit B that communicates with a proximate electromagnetic induction tag 10. *See, Id.* Thus, the JP900 reference could not possibly teach *all* of the features of claim 27. In view of these deficiencies among others, the cited reference cannot anticipate claim 27 or the claims that depend therefrom.

For these reasons among others, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 102.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 4, 6, 8-14, 22-25 and 28-29 as obvious over the JP900 reference. Applicant respectfully traverses this rejection.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather

than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Features of Claim 8 that are Absent from the Cited Reference

The rejection based on the JP900 reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest an "RF transmitter ... configured to not broadcast during operation of the imaging device," as recited by independent claim 8. (Emphasis added.) Conversely, as noted above, the JP900 reference teaches an electromagnetic induction tag capable of broadcasting during operation of the gear A. *See, Id.* In view of these deficiencies among others, the JP900 reference, taken as it stands or hypothetically modified, cannot render obvious claim 8 or the claims that depend therefrom.

Features of Claim 28 that are Absent from the Cited Reference

Here again, the rejection based on the JP900 reference is deficient for a number of reasons. For example, the cited reference does not teach or suggest "code for remotely communicating with the RF device over a network," as recited by independent claim 28. (Emphasis added.) To the contrary, the JP900 reference teaches proximate line-of-sight communication with an electromagnetic induction tag 10. *See Id.* In view of these deficiencies among others, the JP900 reference, taken as it stands or hypothetically modified, cannot render obvious claim 28 or the claims that depend therefrom.

The JP900 reference fails to teach or suggest other features of claim 28 as well. For example, the cited reference does not teach or suggest "code for preventing the RF device from transmitting during operation of the imaging device," as recited by independent claim 28. (Emphasis added.) To the contrary, the JP900 reference teaches an electromagnetic induction tag 10 capable of broadcasting during the operation of gear A. *See, Id.* In view of these deficiencies among others, the JP900 reference, taken alone or in hypothetical combination, cannot render obvious claim 28 or the claims that depend therefrom.

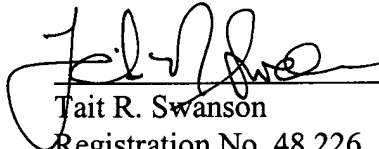
For these reasons among others, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 103.

Conclusion

Applicant respectfully submits that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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